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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/348,774	07/07/1999	WILLIAM M. KLEINFELTER	3207/22	5725

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EXAMINER
MORGAN, ROBERT W

ART UNIT	PAPER NUMBER
3626	15

DATE MAILED: 12/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/348,774	KLEINFELTER, WILLIAM M.	
	Examiner	Art Unit	
	Robert W. Morgan	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 September 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-49* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-49* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Continued Prosecution Application

1. The request filed on 8/29/02 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/348774 is acceptable and a CPA has been established. An action on the CPA follows.

Response to Amendment

2. The amendment filed 9/12/02 has been entered. Now claims 1-49 are presented for examination.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,950,630 to Portwood et al.

As per claim 1, Portwood et al. teaches a computer implemented method for processing prescription data representing a plurality of prescription drugs, said method comprising the steps of:

--the claimed arranging received prescription data that corresponds to a first prescription drug into a new record of a predetermined format containing an identifier for identifying said patient and further containing a first name of said first prescription drug is met by the prescription information being entered and organized according to drug name, units, strength,

prescription signature, refills, dosing mode and a date last administered to the patient (see: column 6, lines 50-54),

--the claimed accessing a plurality of pre-stored records of said predetermined format, each pre-stored record containing information on a plurality of prescription drugs previously prescribed for respective patients is met by the CPU (1, Fig. 4) that allows the patient prescription data or records to be quickly access as well as making and entering any changes to the already existing prescription (see: column 16, lines 47-57); and

--the claimed identifying said first prescription drug as a new therapy start for said patient if said first name is not substantially identical to said second name is met by the Generic Product Identifier (GPI) and National Drug Code (NDC) both used to determine the drug used by a patient and to determine a new recommend or continuing medical regimen (see: column 7, lines 56-67). In addition, Portwood further teaches a Prescribing Duration Check to calculate the prescribing duration for each new drug to be prescribed in a medical regimen (see: column 14, lines 40-58). This suggests that the calculation involved with prescribing duration for each new drug include a new therapy start.

Portwood et al. fails to explicitly teach the claimed comparing said identifier in said new record with each identifier located in the pre-stored records to find a matching pre-stored record associated with said patient and comparing said first name of said first prescription drug with a second name of a second prescription drug located in the found matching pre-stored record.

However, Portwood teaches comparing patient's prescription data which includes but not limited to patient name, drug name, unit and strength (see column 6, lines 5-10 and column 6, lines 50-54) as well as comparing patient's prescription data including the duration and dosage

range of a administered drug as transmitted by the reporting unit (see: column 3, lines 5-10). In addition, Portwood teaches a Prescribing Duration Check to calculate the prescribing duration for each new drug to be prescribed in a medical regimen (see: column 14, lines 40-58). The Examiner considers the Prescribing Duration Check to include comparing the first name of a first prescription drug with the second name of a second prescription drug located in the found matching pre-stored record to determine if a new drug is being prescribed to a patient's regimen. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include comparing a first drug with a second drug to determine a new prescription within the method for processing prescription data as taught by Portwood with motivation of identifying the drugs in a patient's prescription thereby reducing the side effects caused be a reaction to certain drugs.

As per claim 2, Portwood et al. teaches determining whether types of said first and second names are brand or generic if said first name is not substantially identical to said second name, converting one of said first and second names to the type of the remaining name if the types are different, and ascertaining an equivalency between said first and second names based on the converted name is met by comparing the pharmaceutical information (existing prescription) and the patient prescription data (current prescription) which includes the use of the National Drug Code (NDC) and the Generic Product Identifier (GPI) to select the correct drug name needed to full the prescription (see: column 6, lines 50-61 and column 7, lines 56-67).

As per claim 3, Portwood et al. teaches collecting the pre-stored records over a predetermined time interval is met by the printing of several reports such as a prescription

calendar and prescribed medical regimen that need to be collected and transmitted to the patient over the course of the treatment (see: column 16, lines 11-23).

As per claim 4, Portwood et al. teaches a predetermined format further contains a date of dispensing said prescription drug to said patient and a dosage of said prescription drug (see: column 6, lines 50-54).

As per claim 5, Portwood et al. teaches calculating a last day when said patient has taken said second prescription based on said date of dispensing and on said dosage if said first and last names are substantially identical, determining a length of time elapsed between said last day of taking said second prescription drug and a first day of dispensing said first prescription drug, and identifying said first prescription drug as newly prescribed for said patient if said length of time exceeds a predetermined time interval is met by the patient prescription data which includes the length of therapy, drug name, date and time of dosage and patient history all used to determine and calculate the patient prescribed regimen (see: column 6, lines 50-67 and column 11, lines 5663).

As per claim 6, Portwood et al. teaches obtaining each pre-stored record for said patient, accessing a list of illnesses to determine each illness treatable by each respective prescription drug contained in said each pre-stored record, accessing said list of illnesses to determine an illness treatable by said first prescription drug identified as newly prescribed, and ascertaining whether said first prescription drug is a replacement for another prescription drug previously taken by said patient is met by the ability to access the patient prescription which includes a description of the patient's symptoms and drugs used to combat those symptoms as well as all the

stored patient prescription data from any previous treatments (see: column 16, lines 41-43 and column 16, lines 54-58).

As per claim 7, Portwood et al. teaches calculating a last day when said patient has taken said another prescription drug based on said date of dispensing and on said dosage, determining a length of time elapsed between said last day of taking said another prescription drug and a first day of dispensing said first prescription drug, and identifying said first prescription drug as said replacement if said length of time does not exceed a predetermined time interval is met by calculating the DoseUnit and IndividualDose of the patient to determine the dosage, duration and length of therapy between prescriptions (see: column 11, lines 56-66 and column 6, lines 50- 67).

As per claim 8, Portwood et al. teaches said predetermined format further contains a prescriber name, a prescriber address, and a patient zip code (see: column 8, lines 27-29 and 3839).

As per claim 9, Portwood et al. teaches selecting every prescription drug identified as newly prescribed for each patient over a predetermined time interval, and sorting the selected prescription drugs according to at least one criterion selected from the following: a prescriber's name, a prescriber's address, a patient's zip code, a prescriber's specialty, a pharmaceutical sales territory, national-based reporting, ICD9 code is met by the patient prescription data which includes a prescriber's name (see: column 8, lines 27-29).

As per claims 10-18, they are rejected for the same the reasons set forth in claims 1-9.

As per claim 19, Portwood et al. teaches a computer-readable storage medium for storing a program code for, when executed, causing a computer to perform a method for processing prescription data representing a plurality of prescription drugs, said method comprising:

--the claimed arranging received prescription data that corresponds to a first prescription drug into a new record of a predetermined format containing an identifier for identifying said patient and further containing a first name of said first prescription drug is met by the prescription information being enter and organized according to drug name, units, strength, prescription signature, refills, dosing mode and a date last administered to the patient (see: column 6, lines 50-54 and column 7, lines 40-51);

--the claimed accessing a plurality of pre-stored records of said predetermined format, each pre-stored record containing information on a plurality of prescription drugs previously prescribed for respective patients is met by the CPU (1, Fig. 4) that allows the patient prescription data or records to be quickly access as well as making and entering any changes to the already existing prescription (see: column 16, lines 47-57 and column 7, lines 40-51); and

--the claimed identifying said first prescription drug as a new therapy start for said patient if said first name is not substantially identical to said second name is met by the Generic Product Identifier (GPI) and National Drug Code (NDC) both used to determine the drug used by a patient and to determine a new recommend or continuing medical regimen (see: column 7, lines 56-67 and column 7, lines 40-51). In addition, Portwood further teaches a Prescribing Duration Check to calculate the prescribing duration for each new drug to be prescribed in a medical regimen (see: column 14, lines 40-58). This suggests that the calculation involved with prescribing duration for each new drug include a new therapy start.

Portwood fails to explicitly teach the comparing said identifier in said new record with each identifier located in the pre-stored records to find a matching pre-stored record associated

with said patient and comparing said first name of said first prescription drug with a second name of a second prescription drug located in the found matching pre-stored record.

However, Portwood teaches comparing patient's prescription data which includes but not limited to patient name, drug name, unit and strength (see column 6, lines 5-10 and column 6, lines 50-54) as well as comparing patient's prescription data including the duration and dosage range of a administered drug as transmitted by the reporting unit (see: column 3, lines 5-10). In addition, Portwood teaches a Prescribing Duration Check to calculate the prescribing duration for each new drug to be prescribed in a medical regimen (see: column 14, lines 40-58). The Examiner considers the Prescribing Duration Check to include comparing the first name of a first prescription drug with the second name of a second prescription drug located in the found matching pre-stored record to determine if a new drug is being prescribed to a patient's regimen. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include comparing a first drug with a second drug to determine a new prescription within the method for processing prescription data as taught by Portwood with motivation of identifying the drugs in a patient's prescription thereby reducing the side effects caused be a reaction to certain drugs.

As per claim 20, Portwood et al. teaches a computer implemented method for processing prescription data using a plurality of pre-stored prescription data records, each of which comprises a patient identifier identifying a patient and a drug identifier identifying a drug being prescribed to the identified patient of the respective record, the method comprising:

--the claimed receiving a first prescription data record comprising a patient identifier identifying a first patient and a drug identifier identifying a drug being prescribed to the first

patient drug is met by the prescription information being entered and organized according to drug name, units, strength, prescription signature, refills, dosing mode and a date last administered to the patient (see: column 6, lines 50-54);

-- (see: column 3, lines 5-10);

--the claimed determining whether the drug identifier of the matching pre-stored prescription data record is related to the drug identifier of the first prescription data record is met by comparing existing and current patient's prescription data which includes but not limited to patient name, drug name, unit and strength to determine the relationship between the stored data (existing) and the prescription data (current) (see column 6, lines 5-10 and column 6, lines 5054);

--the claimed identifying the drug being prescribed to the first patient as a new therapy start for the first patient if the drug identifier of the first prescription data record is not related to the drug identifier of the matching pre-stored prescription data record is met by the Generic Product Identifier (GPI) and National Drug Code (NDC) both used to determine the drug used by a patient and to determine a new recommend or continuing medical regimen (see: column 7, lines 56-67). In addition, Portwood further teaches a Prescribing Duration Check to calculate the prescribing duration for each new drug to be prescribed in a medical regimen (see: column 14, lines 40-58). This suggests that the calculation involved with prescribing duration for each new drug include a new therapy start.

Portwood fails to explicitly teach the claimed comparing the patient identifier of the first prescription data record to the patient identifier of each of the plurality of pre-stored prescription data records to find a pre-stored prescription data record having a patient identifier matching the patient identifier of the first prescription data record.

However, Portwood teaches comparing patient's prescription data which includes but not limited to patient name, drug name, unit and strength (see column 6, lines 5-10 and column 6, lines 50-54) as well as comparing patient's prescription data including the duration and dosage range of a administered drug as transmitted by the reporting unit (see: column 3, lines 5-10). In addition, Portwood teaches a Prescribing Duration Check to calculate the prescribing duration for each new drug to be prescribed in a medical regimen (see: column 14, lines 40-58). The Examiner considers the comparing of a patient's prescription data including a patient name (identifier) and the calculation of prescribing duration (plurality of pre-stored prescription data records to find a match) as a process of checking for each new drug. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include comparing of a patient identifier with pre-stored prescription data record to find a match within the method for processing prescription data as taught by Portwood with motivation of identifying the drugs in a patient's prescription thereby reducing the side effects caused be a reaction to certain drugs.

As per claim 21, Portwood et al. teaches the step of determining comprises identifying the drug identifier of the matching pre-stored prescription data record as being related to the drug identifier of the first prescription data record if the drug identifier of the matching pre-stored prescription data record matches the drug identifier of the first prescription data record. This feature is met by the comparing and tests of pharmaceutical data and patient data for underdosing and overdosing which indicates a relationship between the pre-stored prescription data record and the first prescription data (column 6, lines 50-67).

As per claim 22, Portwood et al. fails to explicitly teaches a drug identifier is of one of two types, one type of drug identifier being an identifier to a brand name drug and the other type of drug identifier being an identifier to a generic drug corresponding to a brand name drug, and where the step of determining comprises:

--the claimed prior to the step of identifying, if the drug identifier of the matching pre-stored prescription data record and the drug identifier of the first prescription data record are not of the same type, converting either the drug identifier of the matching pre-stored prescription data record or the drug identifier of the first prescription data record to the other type of drug identifier.

However, Portwood teaches comparing patient's prescription data which includes but not limited to patient name, drug name, unit and strength (see column 6, lines 5-10 and column 6, lines 50-54) as well as comparing patient's prescription data including the duration and dosage range of a administered drug as transmitted by the reporting unit (see: column 3, lines 5-10). In addition, Portwood teaches a Prescribing Duration Check to calculate the prescribing duration for each new drug to be prescribed in a medical regimen (see: column 14, lines 40-58). The Examiner considers the comparing of a patient's prescription data including a patient name (identifier) and the calculation of prescribing duration (plurality of pre-stored prescription data records to find a match) as a process of checking for each new drug. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include comparing of a patient identifier with pre-stored prescription data record to find a match within the method for processing prescription data as taught by Portwood with motivation of identifying

the drugs in a patient's prescription thereby reducing the side effects caused be a reaction to certain drugs.

As per claim 23, Portwood et al. teaches a database provides a correspondence between brand name drugs and their corresponding generic drugs, and where the step of converting comprises:

--the claimed drug identifier being conveyed is of the type that identifies a brand name drug, searching the database to find the generic drug corresponding to the brand name drug identified by the drug identifier being converted and modifying the drug identifier being converted to identify the found generic drug is met by the pharmaceutical database which uses the National Drug Code (NDC) and the Generic Product Identifier (GPI) to select the correct drug name needed to full the prescription indicating that brand name drugs are compared with generic (see: column 6, lines 50-61 and column 7, lines 56-67); and

--the claimed drug identifier being converted is of the type that identifies a generic drug, searching the database to find the brand name drug corresponding to the generic drug identified by the drug identifier being converted and modifying the drug identifier being converted to identify the found brand name drug is met by the pharmaceutical database which uses the National Drug Code (NDC) and the Generic Product Identifier (GPI) to select the correct drug name needed to full the prescription indicating that brand name drugs are compared with generic (see: column 6, lines 50-61 and column 7, lines 56-67).

As per claim 24, Portwood et al. teaches the claimed plurality of pre-stored prescription data records are collected over a predetermined time interval. This limitation is met by the printing of several reports such as a prescription calendar and prescribed medical regimen that

need to be collected and transmitted to the patient over the course of the treatment (see: column 16, lines 11-23).

As per claim 25, Portwood et al. teaches plurality of pre-stored prescription data records further comprises a dispensing date on which the drug being prescribed of the respective record was dispensed and a drug dosage describing the dosage prescribed for the drug being prescribed of the respective record, and where the first prescription data record further comprises a dispensing date on which the drug being prescribed of the first prescription data record was dispensed, and where the method further comprises:

--the claimed drug identifier of the matching pre-stored prescription data record is related to the drug identifier of the first prescription data record, calculating a last day the drug being prescribed of the matching pre-stored prescription data record was taken based on the dispensing date and drug dosage for the drug being prescribed of the matching pre-stored prescription data record is met by the patient prescription data which includes the length of therapy, drug name, date and time of dosage and patient history all used to determine and calculate the patient prescribed regimen (see: column 6, lines 50-67 and column 11, lines 56-63);

--the claimed determining a length of time between the last day calculated and the dispensing date of the drug being prescribed of the first prescribed data record is met by the patient prescription data which includes the length of therapy, drug name, date and time of dosage and patient history all used to determine and calculate the patient prescribed regimen (see: column 6, lines 50-67 and column 11, lines 56-63); and

--the claimed identifying the drug being prescribed to the first patient as a new therapy start for the first patient if the length of time determined exceeds a predetermined time interval is

met by the patient prescription data which includes the length of therapy, drug name, date and time of dosage and patient history all used to determine and calculate the patient prescribed regimen (see: column 6, lines 50-67 and column 11, lines 56-63). In addition, Portwood further teaches a Prescribing Duration Check to calculate the prescribing duration for each new drug to be prescribed in a medical regimen (see: column 14, lines 40-58). This suggests that the calculation involved with prescribing duration for each new drug include a new therapy start.

As per claim 26, Portwood et al. teaches a computer implemented method for processing prescription data using a plurality of pre-stored prescription data records, each of which comprises a patient identifier identifying a patient and a drug identifier identifying a drug being prescribed to the identified patient of the respective record, the method comprising:

--the claimed receiving a first prescription data record comprising a patient identifier identifying a first patient and a drug identifier identifying a drug being prescribed to the first patient is met by the prescription information being entered and organized according to drug name, units, strength, prescription signature, refills, dosing mode and a date last administered to the patient (see: column 6, lines 50-54);

--the claimed identifying all the illnesses treatable by the drug being prescribed of the first prescription data record is met by the ability to access the patient prescription that includes a description of the patient's symptoms and drugs used to combat those symptoms (see: column 16, lines 41-43 and column 16, lines 54-58);

--the claimed for each matching pre-stored prescription data record, identifying all the illnesses treatable by the drug being prescribed of the respective pre-stored prescription data record is met by the ability to access the patient prescription which includes a description of the

patient's symptoms and drugs used to combat those symptoms as well as all the stored patient prescription data from any previous treatments (see: column 16, lines 41-43 and column 16, lines 54-58); and

--the claimed determining whether the drug being prescribed of the first prescription data record is a therapy switch based on the illnesses treatable by the drug being prescribed of the first prescription and the illnesses treatable by any drug being prescribed of any of the matching pre-stored prescription data records is met by the ability to access the patient prescription which includes a description of the patient's symptoms and drugs used to combat those symptoms as well as all the stored patient prescription data from any previous treatments (see: column 16, lines 41-43 and column 16, lines 54-58).

Portwood fails to explicitly teach the claimed comparing the patient identifier of the first prescription data record to the patient identifier of each of the plurality of pre-stored prescription data records to find all pre-stored prescription data records having a patient identifier matching the patient identifier of the first prescription data record.

However, Portwood teaches comparing patient's prescription data which includes but not limited to patient name, drug name, unit and strength (see column 6, lines 5-10 and column 6, lines 50-54) as well as comparing patient's prescription data including the duration and dosage range of a administered drug as transmitted by the reporting unit (see: column 3, lines 5-10). In addition, Portwood teaches a Prescribing Duration Check to calculate the prescribing duration for each new drug to be prescribed in a medical regimen (see: column 14, lines 40-58). The Examiner considers the comparing of a patient's prescription data including a patient name (identifier) and the calculation of prescribing duration (plurality of pre-stored prescription data

records to find a match) as a process of checking for each new drug. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include comparing of a patient identifier with pre-stored prescription data record to find a match within the method for processing prescription data as taught by Portwood with motivation of identifying the drugs in a patient's prescription thereby reducing the side effects caused be a reaction to certain drugs.

As per claim 27, Portwood et al. teaches a database lists the illnesses treatable by drugs, and where the step of identifying all the illnesses treatable by a drug being prescribed comprises:

--the claimed given drug being prescribed, searching the database to find the given drug is met by the ability to access the patient prescription which includes a description of the patient's symptoms and drugs used to combat those symptoms as well as all the stored patient prescription data from any previous treatments (see: column 16, lines 41-43 and column 16, lines 54-58); and

--the claimed identifying all the illnesses listed in the database as treatable by the found drug is met by the ability to access the patient prescription which includes a description of the patient's symptoms and drugs used to combat those symptoms as well as all the stored patient prescription data from any previous treatments (see: column 16, lines 41-43 and column 16, lines 54-58).

As per claim 28, Portwood et al. teaches each of the plurality of pre-stored prescription data records further comprises a dispensing date on which the drug being prescribed of the respective record was dispensed and a drug dosage describing the dosage prescribed for the drug being prescribed of the respective record, and where the first prescription data record further

comprises a dispensing date on which the drug being prescribed of the first prescription data record was dispensed, and where the step of determining comprises:

--the claimed identifying one of the plurality of pre-stored prescription data records where the drug being prescribed of the identified record treats an illness that the drug being prescribed of the first prescription data record also treats is met by the patient prescription data which includes the length of therapy, drug name, date and time of dosage and patient history all used to determine and calculate the patient prescribed regimen (see: column 6, lines 50-67 and column 11, lines 56-63);

--the claimed calculating a last day the drug being prescribed of the identified record was taken based on the dispensing date and drug dosage for the drug being prescribed of the identified record is met by calculating the DoseUnit and IndividualDose of the patient to determine the dosage, duration and length of therapy between prescriptions (see: column 11, lines 56-66 and column 6, lines 50- 67);

--the claimed determining a length of time between the last day calculated and the dispensing date of the drug being prescribed of the first prescribed data record is met by calculating the DoseUnit and IndividualDose of the patient to determine the dosage, duration and length of therapy between prescriptions (see: column 11, lines 56-66 and column 6, lines 50- 67); and

--the claimed identifying the drug being prescribed to the first patient as a therapy switch for the first patient if the length of time determined does not exceed a predetermined time interval is met by calculating the DoseUnit and IndividualDose of the patient to determine the

dosage, duration and length of therapy between prescriptions (see: column 11, lines 56-66 and column 6, lines 50- 67).

As per claims 29-36 and 39-46, they are rejected for the same reason set forth in claims 20-27.

As per claim 37, Portwood et al. teaches means for determining identifies the drug being prescribed of the first prescription data record as a therapy switch if any illness treatable by the drug being prescribed of the first prescription data record matches any illness treatable by any drug being prescribed of any of the matching pre-stored prescription data records. This limitation is met by the ability to access the patient prescription that includes a description of the patient's symptoms and drugs used to combat those symptoms as well as all the stored patient prescription data from any previous treatments (see: column 16, lines 41-43 and column 16, lines 54-58).

As per claim 38, Portwood et al. teaches each of the plurality of pre-stored prescription data records further comprises a dispensing date on which the drug being prescribed of the respective record was dispensed and a drug dosage describing the dosage prescribed for the drug being prescribed of the respective record, and where the first prescription data record further comprises a dispensing date on which the drug being prescribed of the first prescription data record was dispensed, and where the means for determining comprises:

--the claimed means for identifying one of the plurality of pre-stored prescription data records where the drug being prescribed of the identified record treats an illness that the drug being prescribed of the first prescription data record also treats is met by the patient prescription data which includes the length of therapy, drug name, date and time of dosage and patient history

all used to determine and calculate the patient prescribed regimen (see: column 6, lines 50-67 and column 11, lines 56-63),

--the claimed means for calculating a last day the drug being prescribed of the identified record was taken based on the dispensing date and drug dosage for the drug being prescribed of the identified record is met by calculating the DoseUnit and IndividualDose of the patient to determine the dosage, duration and length of therapy between prescriptions (see: column 11, lines 56-66 and column 6, lines 50- 67);

--the claimed means for determining a length of time between the last day calculated and the dispensing date of the drug being prescribed of the first prescribed data record is met by calculating the DoseUnit and IndividualDose of the patient to determine the dosage, duration and length of therapy between prescriptions (see: column 11, lines 56-66 and column 6, lines 50- 67); and

--the claimed means for identifying the drug being prescribed to the first patient as a therapy switch for the first patient if the length of time determined does not exceed a predetermined time interval is met by calculating the DoseUnit and IndividualDose of the patient to determine the dosage, duration and length of therapy between prescriptions (see: column 11, lines 56-66 and column 6, lines 50- 67).

As per claimed 47, Portwood et al. teaches the step of determining comprises identifying the drug being prescribed of the first prescription data record as a therapy switch if any illness treatable by the drug being prescribed of the first prescription data record matches any illness treatable by any drug being prescribed of any of the matching pre-stored prescription data records. This limitation is met by the ability to access the patient prescription that includes a

description of the patient's symptoms and drugs used to combat those symptoms as well as all the stored patient prescription data from any previous treatments (see: column 16, lines 41-43 and column 16, lines 54-58).

As per claim 48, Portwood et al. teaches each of the plurality of pre-stored prescription data records further comprises a dispensing date on which the drug being prescribed of the respective record was dispensed and a drug dosage describing the dosage prescribed for the drug being prescribed of the respective record, and where the first prescription data record further comprises a dispensing date on which the drug being prescribed of the first prescription data record was dispensed, and where the step of determining comprises:

--the claimed identifying one of the plurality of pre-stored prescription data records where the drug being prescribed of the identified record treats an illness that the drug being prescribed of the first prescription data record also treats is met by the patient prescription data which includes the length of therapy, drug name, date and time of dosage and patient history all used to determine and calculate the patient prescribed regimen (see: column 6, lines 50-67 and column 11, lines 56-63);

--the claimed calculating a last day the drug being prescribed of the identified record was taken based on the dispensing date and drug dosage for the drug being prescribed of the identified record is met by calculating the DoseUnit and IndividualDose of the patient to determine the dosage, duration and length of therapy between prescriptions (see: column 11, lines 56-66 and column 6, lines 50- 67);

--the claimed determining a length of time between the last day calculated and the dispensing date of the drug being prescribed of the first prescribed data record is met by

calculating the DoseUnit and IndividualDose of the patient to determine the dosage, duration and length of therapy between prescriptions (see: column 11, lines 56-66 and column 6, lines 50- 67); and

--the claimed identifying the drug being prescribed to the first patient as a therapy switch for the first patient if the length of time determined does not exceed a predetermined time interval is met by calculating the DoseUnit and IndividualDose of the patient to determine the dosage, duration and length of therapy between prescriptions (see: column 11, lines 56-66 and column 6, lines 50- 67).

As per claimed 49, Portwood teaches the step of determining comprises identifying the drug being prescribed of the first prescription data record as a therapy switch if any illness treatable by the drug being prescribed of the first prescription data record matches any illness treatable by any drug being prescribed of any of the matching pre-stored prescription data records. This limitation is met by the ability to access the patient prescription that includes a description of the patient's symptoms and drugs used to combat those symptoms as well as all the stored patient prescription data from any previous treatments (see: column 16, lines 41-43 and column 16, lines 54-58).

Response to Arguments

5. Applicant's arguments with respect to claims 1-49 have been considered but are moot in view of the new ground(s) of rejection. However, Applicant argues that Portwood checks prescriptions against pharmaceutical data to verify their integrity and does not compare

prescription against previous prescriptions for the same patient to determine whether a new therapy has begun.

(A) In response, it is respectfully submitted that whether or not the Portwood reference discloses other features such as checking prescription data against pharmaceutical data to verify their integrity is immaterial to the issue at hand, since it is irrelevant whether the applied references contain elements in addition to or beyond those claimed by Applicant, and not required by applicant, insofar as Applicant uses the word "comprising" at end of each preamble of claims 1, 10, 19-20, 29 and 39. The Examiner understands this claim language to mean, "having at least". If Applicant desires to claim an invention that is exclusively limited to only those elements specifically recited in the claims, the Examiner suggests that Applicant use the term "consisting of" rather than "comprising". Moreover, the fact that Applicant has recognized another advantage that flows naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert W. Morgan whose telephone number is (703) 605-4441. The examiner can normally be reached on 8:30 a.m. - 5:00 p.m. Mon - Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (703) 305-9588. The fax phone numbers for the

organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

RWM
rwm
November 26, 2002

DINH X. NGUYEN
PRIMARY EXAMINER

Recent Statutory Changes to 35 U.S.C. § 102(e)

On November 2, 2002, President Bush signed the 21st Century Department of Justice Appropriations Authorization Act (H.R. 2215) (Pub. L. 107-273, 116 Stat. 1758 (2002)), which further amended 35 U.S.C. § 102(e), as revised by the American Inventors Protection Act of 1999 (AIPA) (Pub. L. 106-113, 113 Stat. 1501 (1999)). The revised provisions in 35 U.S.C. § 102(e) are completely retroactive and effective immediately for all applications being examined or patents being reexamined. Until all of the Office's automated systems are updated to reflect the revised statute, citation to the revised statute in Office actions is provided by this attachment. This attachment also substitutes for any citation of the text of 35 U.S.C. § 102(e), if made, in the attached Office action.

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 in view of the AIPA and H.R. 2215 that forms the basis for the rejections under this section made in the attached Office action:

> **A person shall be entitled to a patent unless –**
>
> **(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.**

35 U.S.C. § 102(e), as revised by the AIPA and H.R. 2215, applies to all qualifying references, except when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. For such patents, the prior art date is determined under 35 U.S.C. § 102(e) as it existed prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. § 102(e)).

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 prior to the amendment by the AIPA that forms the basis for the rejections under this section made in the attached Office action:

> **A person shall be entitled to a patent unless –**
>
> **(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.**

For more information on revised 35 U.S.C. § 102(e) visit the USPTO website at www.uspto.gov or call the Office of Patent Legal Administration at (703) 305-1622.